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07/959758

SERIAL NUMBER	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.
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07/959.758 10/21/92 CHUTER

33M1/0201

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EXAMINER	
T	PA-5047-CIP2
ART UNIT	PAPER NUMBER
BRITTINGHAM, D	11

DATE MAILED:  
3308

This is a communication from the examiner in charge of your application.  
COMMISSIONER OF PATENTS AND TRADEMARKS

02/01/94

☒ This application has been examined ☒ Responsive to communication filed on 11-1-93 ☐ This action is made final.

A shortened statutory period for response to this action is set to expire 3 month(s), \_\_\_\_\_ days from the date of this letter.  
Failure to respond within the period for response will cause the application to become abandoned. 35 U.S.C. 133

**Part I THE FOLLOWING ATTACHMENT(S) ARE PART OF THIS ACTION:**

- |   |   |
|---|---|
| 1. <input checked="" type="checkbox"/> Notice of References Cited by Examiner, PTO-892. | 2. <input type="checkbox"/> Notice of Draftsman's Patent Drawing Review, PTO-948. |
| 3. <input checked="" type="checkbox"/> Notice of Art Cited by Applicant, PTO-1448.      | 4. <input type="checkbox"/> Notice of Informal Patent Application, PTO-152.       |
| 5. <input type="checkbox"/> Information on How to Effect Drawing Changes, PTO-1474.     | 6. <input type="checkbox"/> _____   |

**Part II SUMMARY OF ACTION**

1. ☒ Claims 1-20 are pending in the application.  
Of the above, claims 10, 11 and 19 are withdrawn from consideration.
2. ☐ Claims \_\_\_\_\_ have been cancelled.
3. ☒ Claims 12-15 are allowed.
4. ☒ Claims 1-9 are rejected.
5. ☒ Claims 16 and 20, 17 and 18 are objected to.
6. ☐ Claims \_\_\_\_\_ are subject to restriction or election requirement.
7. ☐ This application has been filed with informal drawings under 37 C.F.R. 1.85 which are acceptable for examination purposes.
8. ☐ Formal drawings are required in response to this Office action.
9. ☐ The corrected or substitute drawings have been received on \_\_\_\_\_. Under 37 C.F.R. 1.84 these drawings are ☐ acceptable; ☐ not acceptable (see explanation or Notice of Draftsman's Patent Drawing Review, PTO-948).
10. ☐ The proposed additional or substitute sheet(s) of drawings, filed on \_\_\_\_\_, has (have) been ☐ approved by the examiner; ☐ disapproved by the examiner (see explanation).
11. ☐ The proposed drawing correction, filed \_\_\_\_\_, has been ☐ approved; ☐ disapproved (see explanation).
12. ☐ Acknowledgement is made of the claim for priority under 35 U.S.C. 119. The certified copy has ☐ been received ☐ not been received ☐ been filed in parent application, serial no. \_\_\_\_\_; filed on \_\_\_\_\_.
13. ☐ Since this application appears to be in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under Ex parte Quayle, 1935 C.D. 11; 453 O.G. 213.
14. ☐ Other

EXAMINER'S ACTION

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Applicant's election with traverse of Group I in Paper No. 10 is acknowledged. The traversal is on the ground(s) that "dependent claims 10 and 11 are still directed to the transluminal arrangement of independent claim 1, not an independent method." This is not found persuasive because the method does not further limit the product only in as much as it further defines the specific structure of the product.

The requirement is still deemed proper and is therefore made FINAL.

Claims 5-9, 16 and 20 are rejected under 35 U.S.C. § 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

With respect to these claims, it is not clear whether the main attachment means and the first attachment means are the same structure.

The following is a quotation of the appropriate paragraphs of 35 U.S.C. § 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless --  
(e) the invention was described in a patent granted on an application for patent by another filed in the United States before the invention thereof by the applicant for patent, or on an international application by another who has fulfilled the requirements of paragraphs (1), (2), and (4) of section

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371(c) of this title before the invention thereof by the applicant for patent.

Claims 1-4 are rejected under 35 U.S.C. § 102(e) as being anticipated by Lazarus.

With respect to claim 1, see figure 8, element 89 for the main container means; figure 8, element 88 for the first container means; and, figure 1, element 30 for the retaining means. (Note: Examiner is not giving any weight to the preamble of the claim.)

With respect to claim 2, see figure 8, element 89.

With respect to claim 3, see figure 1, element 30.

With respect to claim 4, see figure 8, element 89.

The following is a quotation of 35 U.S.C. § 103 which forms the basis for all obviousness rejections set forth in this Office action:

A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Subject matter developed by another person, which qualifies as prior art only under subsection (f) or (g) of section 102 of this title, shall not preclude patentability under this section where the subject matter and the claimed invention were, at the time the invention was made, owned by the same person or subject to an obligation of assignment to the same person.

Claims 5-9 are rejected under 35 U.S.C. § 103 as being

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unpatentable over Lazarus in view of Hillstead.

Lazarus discloses a transluminal arrangement comprising a main container means (see figure 8, element 89), a first container means (see figure 8, element 88) and a retaining means (see figure 1, element 30). However, Lazarus fails to disclose a main attachment means. Hillstead discloses an attachment means for attachment of the stent to the catheter in order to deliver the stent in a compressed state for easier insertion. (See figure 2, elements 40, 50 and 51; and, see column 4, lines 12-22.) It would have been obvious to one of ordinary skill in the art to have incorporated the attachment means of Hillstead into the design of Lazarus in order to deliver the Lazarus device in a compressed state for easier insertion.

With respect to claim 6, see Hillstead figure 2, elements 40, 52 and 53.

With respect to claim 7, see Hillstead figure 2, elements 40, 50, 51, 52 and 53.

With respect to claim 8, see column 4, lines 31-59.

With respect to claim 9, see figure 2, element 40.

The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

Gianturco et al. shows a suture for contracting a stent.

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Claims 17 and 18 are objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

Claim 20 would be allowable if rewritten or amended to overcome the rejection under 35 U.S.C. § 112.

Claim 16 would be allowable if rewritten to overcome the rejection under 35 U.S.C. § 112 and to include all of the limitations of the base claim and any intervening claims.

Claims 12-15 are allowable over the prior art of record.

Any inquiry concerning this communication should be directed to Debra S. Brittingham at telephone number (703) 308-3401.



D.S. Brittingham  
January 9, 1994



RANDALL L. GREEN  
SPE  
ART UNIT 338

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Applicant's election with traverse of Group I in Paper No. 10 is acknowledged. The traversal is on the ground(s) that "dependent claims 10 and 11 are still directed to the transluminal arrangement of independent claim 1, not an independent method." This is not found persuasive because the method does not further limit the product only in as much as it further defines the specific structure of the product.

The requirement is still deemed proper and is therefore made FINAL.

Claims 4, 5-9, 16 and 20 are rejected under 35 U.S.C. § 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

With respect to claim 4, line 5, after "positioned" insert -  
- in --.

With respect to claims 5-9, 16 and 20, it is not clear whether the main attachment means and the first attachment means are the same structure.

The above are examples of the type of §112 problems that can be found in the claims. It is Applicant's responsibility to carefully review the claims and correct any §112 problems that exist.

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(e) the invention was described in a patent granted on an application for patent by another filed in the United States before the invention thereof by the applicant for patent, or on an international application by another who has fulfilled the requirements of paragraphs (1), (2), and (4) of section 371(c) of this title before the invention thereof by the applicant for patent.

Claims 1-4 are rejected under 35 U.S.C. § 102(e) as being anticipated by Lazarus.

With respect to claim 1, see figure 8, element 89 for the main container means; figure 8, element 88 for the first container means; and, figure 1, element 30 for the retaining means. (Note: Examiner is not giving any weight to the preamble of the claim.)

With respect to claim 2, see figure 8, element 89.

With respect to claim 3, see figure 1, element 30.

With respect to claim 4, see figure 8, element 89.

The following is a quotation of 35 U.S.C. § 103 which forms the basis for all obviousness rejections set forth in this Office action:

A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

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Subject matter developed by another person, which qualifies as prior art only under subsection (f) or (g) of section 102 of this title, shall not preclude patentability under this section where the subject matter and the claimed invention were, at the time the invention was made, owned by the same person or subject to an obligation of assignment to the same person.

Claims 5-9 are rejected under 35 U.S.C. § 103 as being unpatentable over Lazarus in view of Hillstead.

Lazarus discloses a transluminal arrangement comprising a main container means (see figure 8, element 89), a first container means (see figure 8, element 88) and a retaining means (see figure 1, element 30). However, Lazarus fails to disclose a main attachment means. Hillstead discloses an attachment means for attachment of the stent to the catheter in order to deliver the stent in a compressed state for easier insertion. (See figure 2, elements 40, 50 and 51; and, see column 4, lines 12-22.) It would have been obvious to one of ordinary skill in the art to have incorporated the attachment means of Hillstead into the design of Lazarus in order to deliver the Lazarus device in a compressed state for easier insertion.

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With respect to claim 9, see figure 2, element 40.



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The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

Gianturco et al. shows a suture for contracting a stent.

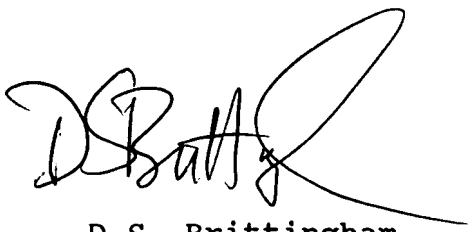
Claims 17 and 18 are objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

Claim 20 would be allowable if rewritten or amended to overcome the rejection under 35 U.S.C. § 112.

Claim 16 would be allowable if rewritten to overcome the rejection under 35 U.S.C. § 112 and to include all of the limitations of the base claim and any intervening claims.

Claims 12-15 are allowable over the prior art of record.

Any inquiry concerning this communication should be directed to Debra S. Brittingham at telephone number (703) 308-3401.

A handwritten signature in black ink, appearing to read 'D.S. Brittingham', with a large, sweeping flourish extending from the end of the signature.

D.S. Brittingham  
January 10, 1994